APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,178	10/11/2000	Neven Karlovac	20528-13	8291

7590 09/17/2004	EXAMINER
Steven C Lieske	HOLMES, MICHAEL B
OPPENHEIMER WOLFF & DONNELLY LLP	

	ART UNIT	PAPER NUMBER
45 South Seventh Street	2121	

3400 Plaza VII
Minneapolis, MN 55402

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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09/689,178</td><td>Applicant(s)
KARLOVAC ET AL.</td></tr>
<tr><td>Examiner
Michael B. Holmes</td><td>Art Unit
2121</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *(3)* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 June 2000*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

UNITED STATES PATENT AND TRADEMARK OFFICE

P.O. Box 1450, Alexandria, Virginia 22313-1450 – www.uspto.gov

Examiner's Detailed Office Action

Response to Amendment

1.   This Office Action is responsive to communication received on June 11, 2004.

Amendment "A" under 37 CFR § 1.111. Reconsideration and allowance of the present

application 09/689,178, filed is respectfully requested by applicant. All such supporting

documentation has been placed in applicant's file.

2.   Claims 1-6 have been amended.

3.   Applicant's arguments filed June 11, 2004 have been fully considered, however,

they are **not** persuasive.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by

Weinberg et al (US Patent Number 6,144,962; Filed 11/7/2000).

Claim 1

Claim 1 recites

A method for choosing components or subsystems for a plurality of generic descriptions in a system design in compliance with one or more system constraints, wherein the generic descriptions represent **the** components or subsystems in the system design, the method comprising:
    (a) choosing a first generic description and a second generic description from the plurality of generic descriptions;
querying a database of objects for finding potential components or subsystems for the first generic description;
    (b) receiving a first answer set from the database of objects, where the first answer set is comprised of at least one component or subsystem candidate for the first generic description;
    (c) querying the database of objects fir finding potential components or subsystems for the second generic description;
    (d) receiving a second answer set from the database of objects, where the second answer set is comprised of at least one component or subsystem candidate for the second generic description;
    (e) testing **one or more (C 27, L 57 to C 28, L 65)** of the combinations of component or subsystem candidates from the first and second answer sets against one or more predefined system constraints; and
    (f) determining at least one solution set, where each solution set is one of the combinations of **the** component or subsystem candidates which best complies with the one or more predefined system constraints.

Claim 1 is anticipated by Weinberg, wherein Weinberg teaches:

(a)-(d) See (Weinberg Figs. 17 and 20; Col 3 L. 9-63, "In accordance... a

Web site."; Col 27 L. 1-13, "As generally... non-OK URLs."; Col 27 L. 57-Col

28 L. 65, "By way of... view of the map.");

(e)-(f) See (Weinberg Fig. 17; Col 1 L. 34-40, "Company webmasters...

congested links."; Col 27 L. 57-Col 28 L. 65, "By way of... view of the map.").

Claim 2

Claim 2 recites "The method for choosing components or subsystems for

a plurality of generic descriptions in a system design from claim 1, wherein the

generic descriptions are blocks of a block diagram", which is anticipated by

Weinberg:

➢ See §102 rejection for claim 1, *supra*, and (Weinberg Figs. 1-5, 13-16, 18,

21, and 23-24).

Claim 3

Claim 3 recites "The method for choosing components or subsystems for

a plurality of generic descriptions in a system design from claim 1, wherein at

least one of the one or more predefined system constraints depends on the

cumulative contribution of each of the component or subsystem candidates",

which is anticipated by Weinberg:

➤ See §102 rejection for claim 1, *supra*, and (Weinberg Fig. 17; Col 1 L. 34-

40, "Company webmasters... congested links."; Col 27 L. 1-13, "As

generally... non-OK URLs.").

Claim 4

Claim 4 recites

A method for verifying whether components or subsystems for a plurality of generic descriptions in a system comply with one or more system constraints, wherein the generic descriptions represent **the** components or subsystems of the system, the method comprising:

(a) choosing a first generic description and a second generic description from the plurality of generic descriptions; querying a database of objects for finding potential components or subsystems for the first generic description;

(b) receiving a first answer set from the database of objects, where the first answer set is comprised of at least one component or subsystem candidate for the first generic description;

(c) assigning a first candidate object from the first answer set to the first generic description;

(d) querying the database of objects for finding potential components or subsystems for the second generic description;

(e) receiving a second answer set from the database of objects, where the second answer set is comprised of at least one component or subsystem candidate for the second generic 20 description;

(f) assigning a second candidate object from the second answer set to the second generic description; and

(g) testing whether the first and second candidate objects comply with **one or more** predefined system **constraints** **(C 27, L 57 to C 28, L 65**, *note the constraint can be the choice of processing byway of Microsoft as opposed to Netscape. In order to execute the product will have to be adapted to run i.e., satisfy, either system constraints*).

Claim 4 is anticipated by Weinberg, wherein Weinberg teaches:

(a)-(f) See (Weinberg Figs. 17, 20, and 22; Col 3 L. 9-63, "In

accordance... a Web site."; Col 27 L. 1-13, "As generally... non-OK URLs.");

(g) See (Weinberg Fig. 17; Col 1 L. 34-40, "Company webmasters...

congested links."; Col 27 L. 57-Col 28 L. 65, "By way of... view of the map.";

Col 27 L. 57-Col 28 L. 65, "By way of... view of the map."; Col 30 L. 66-Col 31

L. 24, "XI. Link Repair... the missing file.").

Claim 5

Claim 5 recites "The method for <u>verifying</u> claim 4, wherein the generic

descriptions are blocks of a block diagram", which is anticipated by Weinberg:

> See §102 rejection for claim 4, *supra*, and (Weinberg Figs. 1-5, 13-16, 18,
>
>   21, and 23-24).

Claim 6

Claim 6 recites "The method for <u>verifying</u> from claim 4, wherein at least

one of the one or more predefined system constraints depends on cumulative

contribution of each of the <u>components or subsystems</u>", which is anticipated by

Weinberg:

> See §102 rejection for claim 4, *supra*, and (Weinberg Fig. 17; Col 1 L. 34-
>
>   40, "Company webmasters... congested links."; Col 27 L. 1-13, "As
>
>   generally... non-OK URLs.").

Response to Arguments

4.   Applicant argues:

(1) Applicants' invention and the Weinberg Invention are in Entirely Different Fields.

Examiner's response: that may be true. However, the statutory requires states

" (e) the invention was described in (1) an application for patent ... " *the prior art employed in*

the examination does not have to be in the same filed as applicant's invention. If the

concept embodied in the prior art "describes" the invention. Then it satisfies the

statutory requirements.

(2) ... one embodiment of the Applicants' invention broadly may be regarded as a tool for

use by engineers as they design a new electrical system, such as for an integrated circuit

board. *Examiner's response: This may be true, and articulated in the written description*

of the specification. However, it is not articulated in the claim language. Moreover, the

courts have been clear regarding the language of the claims. see In re Hiniker Co..,

47 USPQ2d 1523, 1529 (Fed. Cir. 1998). The U.S. Court of Appeals for the Federal

Circuit have used the phraseology *"the name of the game is the claim."*

(3) The Weinberg invention is not in the field of engineering discovery. *see Examiner's*

response, above. Rather, Weinberg provides a system for visualizing web sites and their

content. One skilled in the art of engineering discovery would not search the field of

website visualization for answers to problems in the field of discovery. *Examiner's*

response: That may or may not be true. However, in the broadest reasonable

interpretation, the claim language employed by applicant e.g., "A method for choosing

components or subsystems for a plurality of *generic descriptions in a system design* in

compliance with one or more system constraints ..." *which could be any system i.e.,*

especially, when the claims make no mention of "engineering discovery." *Further, the*

definition of "Engineering" is broad enough to include "the design and manufacture of

complex products <Software~> Merriam-Webster's ... Furthermore, IEEE defines:

Software Engineering as (A) The application of a systematic, disciplined, quantifiable

approach to the development, operation, and maintenance of software; that is, the

application of engineering to software.

Examiners Summary

5.   Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A
shortened statutory period for reply to this final action is set to expire THREE MONTHS
from the mailing date of this action. In the event a first reply is filed within TWO
MONTHS of the mailing date of this final action and the advisory action is not mailed
until after the end of the THREE-MONTH shortened statutory period, then the shortened
statutory period will expire on the date the advisory action is mailed, and any extension
fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory
action. In no event, however, will the statutory period for reply expire later than SIX
MONTHS from the date of this final action.

Correspondence Information

6.   Any inquiries concerning this communication or earlier communications from the
examiner should be directed to **Michael B. Holmes** who may be reached via telephone at
(703) 308-6280. The examiner can normally be reached Monday through Friday between
8:00 a.m. and 5:00 p.m. eastern standard time.

        If you need to send the Examiner, a facsimile transmission regarding After Final
issues, please send it to **(703) 746-7238**. If you need to send an Official facsimile trans-

mission, please send it to **(703) 746-7239**. If you would like to send a Non-Official (draft)

facsimile transmission the fax is **(703) 746-7240**. If attempts to reach the examiner by

telephone are unsuccessful, the **Examiner's Supervisor, Anthony Knight**, may be reached

at **(703) 308-3179**.

Any response to this office action should be mailed too:

Director of Patents and Trademarks Washington, D.C. 20231. Hand-delivered

responses should be delivered to the Receptionist, located on the fourth floor of

Crystal Park II, 2121 Crystal Drive Arlington, Virginia.

Michael B. Holmes
Patent Examiner
Artificial Intelligence
Art Unit 2121
United States Department of Commerce
Patent & Trademark Office

Anthony Knight
Supervisory Patent Examiner
Group 3600